UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAN DAVID WATSON, MICHAEL WENDLAND, PER JYNGE, JAN OLOF KARLSSON, HEIDI BRUROK, PAL RONGVED and MAYTHEM SAEED

Application No. 09/975,317

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on June 13, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below:

In an amendment filed November 16, 2004, appellants cancelled claims 1-75 and submitted new claims 75-95. In the final rejection mailed December 22, 2004, the examiner indicated that the amendment would be entered and rejected the new claims 75-77, 79-82, 87-95 under 35 USC § 102(b) as being anticipated by Rocklage, (U.S. Patent 5,190,744), and claims 83-86 and 78 under 35 USC § 103(a) as unpatentable over Rocklage, (U.S. Patent 5,190,744) in view of Rocklage, (U.S. Patent 4,889,931). In an after final amendment filed August 22, 2005, appellants submitted a new listing of claims canceling claims 75, 82, 83, 87, 94 and 95 and adding new claim 96. In the Advisory Action mailed on September 20, 2005 in response to the

after final amendment, the examiner indicated that the amendment would be entered and added reasons why the rejections would be maintained.

In the examiner's answer mailed December 28, 2005, the examiner withdrew the §102 rejection of the claims 76, 77, 79-81, 88-93 and rejected them anew (adding new claim 96 to the rejection) under 35 USC §103(a) as obvious over Rocklage, (U.S. Patent 5,190,744) in view of Rocklage, (U.S. Patent 4,889,931). In regards to the rejection the examiner stated on page 6 of the answer that "[t]he above rejections were modified in response to the after final amendment [filed August 22, 2005] . . . . The modification is necessary to be consistent with the newly added and amended claims. Thus, the above modification is not viewed as a new grounds of rejections." However, the Manual Of Patent Examining Procedure (MPEP) § 1207.03 (8th ed., Rev. 3, August 2005) states in part:

> **III. SITUATIONS THAT ARE NOT CONSIDERED AS NEW GROUNDS OF REJECTION**
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> There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection.
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> In addition, former 37 CFR 1.193 (a)(2) also provide[s] that if:
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> (A) an amendment under 37 CFR 1.116 [or 41.33] proposes to add or amend one or more claims;
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> (B) appellant was advised (through an advisory action) that the amendment would be entered for purposes of appeal; and

> (C) the advisory action indicates which individual rejection(s) set forth in the action from which appeal has been taken would be used to reject the added or amended claims, then
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> (1) the appeal brief must address the rejection(s) of the added or amended claim(s) and
>
> (2) the examiner's answer may include the rejection(s) of the added or amended claims. Such rejection(s) made in the examiner's answer would not be considered as a new ground of rejection.

As per the above, although the Advisory Action mailed on September 20, 2005 in response to the after final amendment indicated that the amendment would be entered (see (B) above) the examiner did not specifically state which individual rejection(s) set forth in the final rejection would be used to reject the added or amended claims (See (C) above). Therefore, appellants could not have properly addressed the rejection(s) of the added or amended claim(s) (see (C) (1) above). Consequently, we consider the "modification" of the rejections in the examiner's answer with respect to the 37 CFR § 1.116 [or 41.33] amendment to be a new ground of rejection.

(MPEP) § 1207.03 also states,

> Any new ground of rejection made by an examiner in an answer must be:
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> (A) approved by a Technology Center (TC) Director or designee; and
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> (B) prominently identified in the "Grounds of Rejection to be Reviewed on Appeal" section and the "Grounds of Rejection" section of the answer

Additionally, the references need to be listed under heading "**(8) Evidence Relied Upon**" on page 2 of the answer where it is currently stated that "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal." Correction is required.

Also, although the listing of the claims in the claims appendix of the brief is correct, it is noted that both the appeal brief and the answer list the canceled claims 75, 82, 83, 87, 94 and 95 when listing the grounds rejections to be reviewed on appeal (e.g., see page 4 of brief, page 3 of answer). Correction is required.

Accordingly, it is

ORDERED that the application is returned to examiner for the examiner

a.) to take corrective action in resolving the entry of a new ground of rejection in an examiner's answer,

b.) to list the evidence relied upon in the appealed claims (e.g., Rocklage, (U.S. Patent 5,190,744) and Rocklage, (U.S. Patent 4,889,931) under the "Evidence Relied Upon" heading in the examiner's answer,

c.) to take corrective action in resolving the discrepancy of the inclusion of cancelled claims in the rejections to be reviewed on appeal in the brief and the answer, and

d.) for such further action as may be appropriate.

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